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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,376	03/20/2002	Serge Haumont	4925-184PUS	9736
7590	06/07/2006			EXAMINER BEAMER, TEMICA M
Michael C Stuart Cohen Pontani Lieberman & Pavane 551 Fifth Avenue Suite 1210 New York, NY 10176			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/980,376	HAUMONT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Temica M. Beamer	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17,19,21-60 and 77-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17,19,21-60 and 77-97 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed March 6, 2006 have been fully considered but they are not persuasive. Applicant argues that Rinne taken alone or in combination with Blausten fails to disclose a RNC used for determining if a connection between an end element and a mobile station is to be released. The examiner, however, disagrees.

Rinne discloses a method and system for controlling a radio communications network and radio network controller. Rinne further discloses wherein a need for a handover is determined. Such determination is initially made by a mobile station or a base station as shown in col. 7, lines 56-67 and col. 8, lines 32-51, which sends messages throughout the system about the strength of signal connections. However, Rinne still reads on the RNC determining that a new connection has to be made since it is shown that the RNC decode these messages and also realize the functions requested in the messages (col. 8, lines 40-51). Rinne further discloses that "when" the RNC "finds" in a message that a new base station required by the mobile terminal belongs to another controller RNC, it informs the anchor controller RNC about the handover request.

Therefore, it can be concluded that the RNC determines that a connection between an end element and a mobile station based on decoding a handover request message from a mobile station.

Based on the above remarks, the rejection to claims stands as set forth below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-8, 12-17, 19, 21-23, 31-60 and 77-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Rinne et al (Rinne), U.S. Patent No. 6,574,473. ***Please note that all of the claims identified above were inadvertently left out of the heading of the 102 rejection but were rejected under 102.***

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1 and 97, Rinne discloses a network element (i.e., reads on radio network controller) for use in a communication network, said network element being arranged between a mobile station (i.e., or terminal) and an end element (i.e., reads on MSC), wherein connections are established between said mobile station and said end element (MSC) via said network element (col. 5, lines 35-45 and col. 8, lines 23-32, see Fig. 7), said network element comprising means for determining if the connection between said end element and said mobile station is to be released (i.e., handover from one an anchor RNC to other RNC, wherein link between anchor RNC and old RNC is removed, hence connection between end element or MSC and mobile station is released) (col. 6, lines 4-14, col. 8, lines 23-31 and col. 10, lines 7-18, see Fig. 7).

Regarding claim 2, Rinne discloses a network element as claimed in. claim 1, wherein said network element is arranged to release said connection when the determining means determines that the connection is to be released (col. 3, lines 24-42, col. 4, lines 40-48)

Regarding. claim 3, Rinne discloses a network element as claimed in claim 2, wherein said network element is arranged to release the connection between the network element and said mobile station (col. 5, lines 35-45, col. 7, lines 56-67 and col. 10, lines 7-29).

Regarding claims 4-8 and 23, Rinne discloses a network element as claimed in claims 1 , 5,6, 7 and 3, respectively, wherein said network element is arranged to send a message (and reques and in response to a release command

received from end element) (i.e., release bearers or handover complete) to the end element indicating that said connection has been released (col. 10, line 44 to col. 11, line 57 and see Figs. 11 and 12).

Regarding claim 12,31-40, Rinne discloses a network element as claimed in claims 1-11 , respectively, wherein said determining means is arranged to determine if the connection is to be released based on the state of the mobile station .(col. 10,lines 44-53).

Regarding claim 13-17,41-60, Rinne discloses a network element as claimed in claims 1-11, respectively, wherein said determining means is arranged to determine if the connection should be released based on the movement ( and location) of said mobile station (i.e., reads on the fact that handover is determined based on location or movement of mobile station within the base station set of a radio network controller) (col . 17,lines 19-45).

Regarding claims 19,77-93, Rinne discloses a network element as claimed in claims 1-11 , respectively, wherein said network element is a radio network controller (col. 5, lines 35-45) and includes an end station (i.e., reads on mobile station) and an end element (i.e., reads on base station) (col. 5, lines 35-45).

Regarding claims 21-22,94-96, Rinne discloses a network element as claimed in claim 19, wherein said end element is SGSN and said network operates in accordance with the UMTS standard (col. 2,line 65 to col. 3,line 7 and col. 15,lines 8-11).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rinne in view of Blausten, U.S. Patent No. 4,443,875.

Regarding claims 9-11 , 24-30, Rinne discloses a network element as claimed in claims 1-8, respectively. Rinne, however, fails to explicitly disclose wherein said determining means determines that the connection is to be released if the connection has not been used for a predetermined time.

In a similar field of endeavor, Blausten discloses wherein said determining means determines that the connection is to be released if the connection has not been used for a predetermined time (col. 3,lines 24-31).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Rinne to include a elapse time for terminating a connection for handoff for the purpose of delaying the process request is the connection is not being used, hence preserving resources.

***Reassignment Affecting Application Location***

6. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Jemicia N. Beamer*  
JEMICIA BEAMER  
PRIMARY EXAMINER